

Atty. Docket No. 006385.00001

REMARKS

The pending claims (new claims 11 - 22) are directed to a novel method of presenting a baseball game for viewing (and re-viewing). The claims are supported by the original application and do not add any new matter. Those skilled in the relevant art are well versed in the conduct of a baseball game and with that understanding the claims are clear and definite. The claims are directed specifically to a method in which a pre-recorded baseball game (*i.e.*, an analog or digital recording) is edited, such as on an inning-, or half-inning-by inning basis, or following the completion of the complete game, to remove substantially all aspects of the pre-recorded game that do not directly impact the outcome of the game, *i.e.*, save for the outcome-determinative action associated with each batter that comes to the plate. In this way, the sum total of all the action of an entire baseball game that is reflected in the box score for each participant in the game is consolidated into about 10-20 minutes of video.

Applicants would like to thank Examiner Chambers for the courtesies extended to their undersigned representative in the interview held on August 26, 2003. The points and authorities discussed during the interview are fully reflected in the following remarks.

The disclosure was objected to because it was not submitted in the appropriate format. The Office Action required a substitute specification. In accordance with that request, applicants are submitting a substitute specification, excluding claims, in accordance with Rule 1.125. Both a clean and a marked-up copy of the substitute specification are supplied as attachments to this paper. As detailed below, the submitted specification does not include any new matter.

In paragraph [0001], applicants identify their prior-filed Provisional application. The identity of this provisional application was reflected in the original declarations filed in the subject application and it is noted on the file receipts that have been issued for the application. In paragraph [0002], the inherent consequence of the method embodied in the application as filed is recited (the reduction in time for replaying the edited product and the use of the modifier "outcome-determinative" before action is inherent in the disclosed method) to more properly capture the field of the invention. The Board and the CCPA (predecessor to the Federal Circuit) have repeatedly indicated that adding an inherent detail to an application (same as correcting an

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application by amendment to an include an inherent detail) does not add new matter into an application, (e.g., see *In re Nathan*, 140 USPQ 601 (CCPA 1964) and *Ex parte Marsili et al.*, 214 USPQ 904 (PTOBA 1079) in the chemical arts, but the same principle applies in all technologies). Minor editorial changes are made in paragraph [0003].

Paragraph [0006] is a completely new section/addition and is essentially a restatement of the invention summary. Additionally, inherent aspects that are implicitly reflected in the application and aspects that are readily understood by those skilled in the art, as gleaned from the application as originally filed, also are explicitly described (i.e., added) so as to present the invention more clearly for examination by the Patent Office and for consideration by the public upon issuance. For example, the reference to Major League Baseball's prior recording of games is a well-known fact that is not needed to support the claimed invention but helps to put the invention in context. The reference to an "analog" record is inherent in the reference to film and tape recordings. The sentence(s) referring to the techniques for editing again would be apparent to skilled workers from the original description of the method. The final sentence relating to inclusion of a soundtrack to help explain the edited recording is merely an exposition of what is inherent to the skilled worker from the last sentence of paragraph [0005].

In paragraph [0007], a sentence has been added which recites implicit content, understood by the skilled worker, from the sentences immediately preceding and following the insertion. Inserted paragraph [0008] is simply another summary statement of the nature of the invention, clearly evident from the application as originally filed. Finally, paragraph [0010] recites what is an inherent characteristic of every patent application. As explained, no new matter is added.

The Office Action also objects to the specification under 37 C.F.R. 1.71 alleging the application does not adequately teach how to make or use the invention and rejects claims 4-10 under 35 U.S.C. 112, first paragraph. This objection and rejection is respectfully traversed.

The invention is directed to a novel way of replaying or rebroadcasting a baseball game. The technology for recording a baseball game, whether by using analog or digital equipment, is so well known it requires no description. Indeed, given the general availability and widespread

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use of such equipment, the case law makes it clear that patent applications should not be burdened with the disclosure of such well-know material. The same is true of video editing equipment, whether digital or analog. Indeed, as part of the obviousness rejection, considered in more detail below, the Office Action cites commercially available equipment and services that could be used to practice the claimed method. Again, the specification should not be burdened with a description of such well-know material.

It is evident that those skilled in the art can readily practice the invention described and claimed in the pending application. Those skilled in the art can readily prepare a recording of a baseball game, as well as any inning or half-inning thereof, and can readily edit the game action, so as to distill the recording down to those actions that contribute directly to the outcome of the contest, *i.e.*, the result that occurs following the last pitch thrown to each batter for each turn at the plate, or the tagging out or safe advancement of a base runner as may occur in a pick-off play or if the runner is caught stealing. Anyone with even a rudimentary knowledge of the game of baseball can envision what aspects of the pre-recorded game to remove and what to retain in the editing process to accomplish the stated result based on the originally filed application. Of course, one can, within the spirit of this invention, include a minor amount of extraneous recorded information in the edited version, *e.g.*, a video clip of a young fan watching the game, or a video clip of a coach or manager giving signals or changing the pitcher, so as to accent the summary presentation provided by this invention. Thus, the use of the word "substantially" to modify certain aspects of the claimed method. The objective of the invention is to present a complete summary of the action that is recorded in the original game, as reflected in the box score for each participant in the game, so that the action is consolidated into about 10-20 minutes of video.

Claims 4-10 stand rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for a variety of reasons. These rejections are respectfully traversed.

Applicants present new claims 11-22 for examination. Applicants submit that those skilled in the art readily understand the metes and bounds of the subject matter embraced by the newly presented claims and thus the claims are clear and definite.

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Claims 4-10 stand rejected under 35 U.S.C. 101 as embracing non-statutory subject matter. This rejection is respectfully traversed.

The U.S. Supreme Court in *Diamond v. Chakrabarty* made it clear that any thing under the sun invented by man is amenable to patent protection. Consistent with the Supreme Court's edict, the Federal Circuit, in the *State Street Bank* case, further made it clear that methods of doing business are statutorily acceptable subjects for patents. Regardless of which technology you assign the claimed method, or whether you simply consider it a way of doing business, the courts have made it clear that the disclosed and claimed subject matter is available for patenting. Here the method is one which would be practiced with well known recording and editing equipment and the method produces a concrete and tangible result, i.e., the edited recording of the outcome-determinative aspects of a baseball game (see *In re Alappat*). As well be explained in more detail in connection with the obviousness rejection, Major League Baseball is currently practicing the claimed method and selling access to the edited product of the claimed method over the Internet. Surely, a method that leads to a tangible product (the edited video) that can be (and is being) sold, is a method that can be protected by a patent.

Claims 4-10 stand rejected under 35 U.S.C. 103 as being unpatentable over VideoOccassions. This rejection is respectfully traversed.

It appears that the VideoOccassions citation is a print of a website for a video editing business. Included within the citation are suggestions to make video tapes of "school plays, proms and parties," to prepare a "highlight" tape for the coach's game tapes," to prepare a tape of "the really great plays of the season" and the like.

These general suggestions to videotape and edit events, including sporting events, does not disclose or even suggest the important features of the claimed invention. The invention is NOT directed to simply making a "highlight" tape of a baseball game, as for example one might see on ESPN's SportCenter. Rather, the invention is directed to a method of editing a pre-recorded baseball game, whether the complete game or selected portions, such as by half-innings or full innings, to show every outcome-determinative pitch to each batter; while substantially eliminating all non-outcome-determinative action from the edited recording. In this way the

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edited video shows only the outcome of each at bat in the game, such as the strike-out pitch, the base hit, the home run, the hit batter, the ground out, the fly out, the double play ball, etc. Obviously, such a record is not merely a highlight reel. The concept of making a highlight tape does not suggest making such an edited record of an entire baseball game, either on the fly, such as an inning-by-inning, or half-inning-by-half-inning basis, or following the completion of the game, containing only the action directly impacting the outcome of the game.

The claimed invention has been commercially adopted by Major League Baseball (MLB). In this regard, applicants suggest that the Examiner visit and review Major League Baseball's website, www.mlb.com, to examine its on-line product Condensed Games, found in the video scroll down tool bar. It is applicants' understanding that MLB's Condensed Games product is prepared using applicants claimed invention of editing a baseball game down to its outcome-determining action to produce a video record of 15-20 minutes in duration. MLB's Condensed Games was introduced as a potential offering by MLB in Spring 2002 (less than a year before applicants current filing date (see footnote 1, *infra*) and long after applicants conception embodied in the provisional application of June 2000)). For the Examiner's review applicants provide printed documents from four websites associated with the Condensed Games product (1) a Press release of MLB apparently dated March 27, 2001, (2) a Press release of MLB apparently dated March 5, 2002 describing Condensed Games, (3) a Press release of MLB apparently dated April 1, 2003 showing the success of its website and (4) a article written about Condensed Games, extolling its advantages. For the convenience of the examiner, these documents are listed on an attached form PTO-1449 as citations AA, AB, AC and AD, respectively. Applicants submit that MLB's adoption and marketing of this technology is objective indica of its non-obviousness and thus its patentability.

Th adoption by MLB of this method, decades after pre-recording of games was begun and years after the technology of providing such a product/service over the internet was available, stands as an uncontested tribute to the ingenuity and inventiveness of the claimed method. Indeed, note MLB's own use of the term "revolutionary" to modify its condensed game product in the Press Release of 2002 (Document AB).

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This information demonstrates the patentability of the subject matter defined by the pending claims.

Applicants also wish to make of record their efforts to have Major League Baseball take/acquire an interest in their invention. Those efforts started in the summer of 2000. Enclosed is a letter written to Mr. Ethan Orlinski, the General Counsel of MLB, by Mr. Greg Mockry, one of the named inventors, illustrative of that effort in August 2000.

Such efforts by the inventors, to attempt to find someone to buy or license rights in the invention, do NOT place the "invention" on-sale within the ambit of 35 U.S.C. 102(b), see *In re Kollar*, 62 USPQ2d 1425 (Fed. Cir. 2002). See also, *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1217, 48 USPQ2d 1010, 1019 (Fed. Cir. 1998) (determining that a patent was not invalid under the on-sale bar because, *inter alia*, the conveyance of "production rights in the invention" and/or "the exclusive right to market the invention" was not "a sale or an offer to sell the devices themselves") and *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1267, 229 USPQ 805, 809 (Fed. Cir. 1986) (holding that an assignment of rights in an invention in exchange for a share of any proceeds from commercialization did not invalidate claims at issue because "an assignment or sale of the rights in the invention and potential patent rights is not a sale of 'the invention' within the meaning of section 102(b)" (emphasis added)).

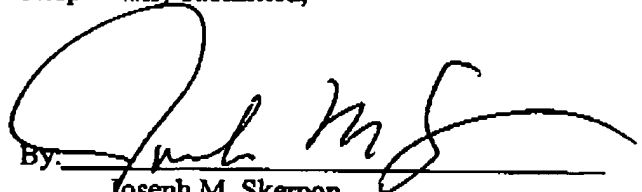
Also, the press release dated in March 2001, a date more than a year before the filing date given to the present invention¹ does not constitute an effective reference under 35 U.S.C. 102. This press release does NOT provide an enabling disclosure and does not provide a sufficiently complete description of the invention to serve as an anticipation of the claimed invention. One can only speculate on its meaning when viewed with the hindsight of subsequent information that is not prior art.

¹ For the record, applicants intend to renew their petition for their original June 2001 file date—a date which would extend their priority back to June 2000 by virtue of the original provisional application.

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On the basis of the foregoing, prompt consideration of all claims in the subject application is respectfully requested.

Respectfully submitted,

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